



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/491,467	01/26/2000	Yoshifumi Sakamoto	13178(JA998-139)	8561

7590 04/07/2003

Richard L Catania
Scully Scott Murphy & Presser
400 Garden City Plaza
Garden City, NY 11530

EXAMINER

MA, JOHNNY

ART UNIT

PAPER NUMBER

2614

DATE MAILED: 04/07/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

33

Office Action Summary	Application No.	Applicant(s)
	09/491,467	SAKAMOTO ET AL. <i>(D)</i>
Examiner	Art Unit	
Johnny Ma	2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 27 January 2003.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1,3-9 and 12 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1,3-9 and 12 is/are rejected.

7) Claim(s) 8 and 12 is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

Response to Arguments

Applicant's arguments with respect to claims 1-12 have been considered but are moot in view of the new ground(s) of rejection. However, the following should be noted, with respect to the Darbee et al. and Huang et al. references.

Applicant characterizes the Darbee et al. reference as a display on a remote control hand-held unit whereby scrolls of a program guide information may be shown on a small display surface, or alternatively, possibly a pictorial display may be superimposed thereon thereby concurrently blocking viewing access to the particular program guide. In essence applicant argues Darbee et al. does not disclose concurrently displaying the EPG data, as set forth in claim 1. However it is believed the applicant has mischaracterized the Darbee et al. reference. The Darbee reference clearly discloses the concurrent display of EPG data where in one particularly innovative aspect, the present invention is directed to a remote control unit having a graphic display for depicting program scheduling and/or advertising information without causing an interruption in content that is being depicted on an associated television monitor (2:45-49). The Darbee et al. reference also discloses it will also be appreciated that, by depressing the EZ NAV key, it is possible to effect channel selections. For example, if a program depicted on the display 14 of the remote control unit 10 is highlighted, one need only depress the EZ NAV key 20 to select that channel for viewing on an associated television set (not shown) (11:5-11). The pictorial display which may block viewing of a particular program guide referred to by applicant

is the display of advertisements. It is clearly not that for which the examiner refers upon in claim

1. Consequently the applicant's argument is considered to be without merit.

Applicant further argues Huang et al. is not adapted to provide information as to an electronic program guide and pictorial or image program representation in a concurrent manner for the types of equipment under consideration and as claimed herein. The examiner respectfully disagrees, the Huang et al. reference does in fact provide concurrent display where the invention provides significant advantages over conventional "on-screen" electronic program guides because it does not require the television screen to be obscured by TV listings. Providing listings and other services on-remote allows for pre-screening of listings and the use of other features without disturbing other who are watching the TV (Huang et al. 19:1-6). However it is relied upon only for the purpose of touch screen functionality. Consequently the applicant's argument is considered to be without merit.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 8 is rejected because the examiner cannot ascertain the scope of claim 8 because it incorporates language of cancelled claim 10. As amended claim 8 reads "A digital broadcast receiver comprising a transmitting means for transmitting EPG data contained in a received

digital broadcast data; a receiving means for receiving EPG data transmitted from the digital broadcast receiver; and selecting apparatus **according to claim 10**, comprising a display means for concurrently displaying said received EPG data. However, for the purpose of examination the examiner interprets claim to read “a digital broadcast receiver comprising a transmitting means for transmitting EPG data contained in a received digital broadcast data; a receiving means for receiving EPG data transmitted from the digital broadcast receiver; and selecting apparatus comprising a receiving means for receiving EPG data transmitted from the digital broadcast receiver, comprising a display means for concurrently displaying said received EPG data.” Appropriate correction is required.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
2. Claims 1-5, 7-12 rejected under 35 U.S.C. 103(a) as being unpatentable over Darbee et al. (US 6,130,726).

As to claim 1, the claimed digital broadcast receiver having a transmitting means for transmitting electronic program guide (EPG) data contained in a received digital broadcast data; a program display and selecting apparatus having a receiving means for receiving the EPG data transmitted from said digital broadcast receiver; and said program display and selecting apparatus comprising a displaying means for concurrently displaying the received EPG data.

The Darbee et al. reference discloses a remote control unit with an IR or RF communication link to an associated set-top box (8:48-52) where the remote control unit includes an IR or RF transmitting and receiving circuits (7:10,18-21). The Darbee et al. reference also discloses that a program guide and advertising data signal may be combined with television channel signals on a coaxial cable to form a composite signal where the composite signal may be broadcast by a content provider, such as a cable company or satellite network, and delivered to a set-top box (8:58-66). The Darbee et al. reference also discloses that the program guide is operated on a small 5-line by 20-character LCD screen or display that is provided on the remote control unit, which satisfies the claimed EPG data displaying means. The Darbee et al. reference also discloses in one particularly innovative aspect, the present invention is directed to a remote control unit having a graphic display for depicting program scheduling and/or advertising information without causing an interruption in content that is being depicted on an associated television monitor (2:45-50). The Darbee et al. reference also discloses it will also be appreciated that, by depressing the EZ NAV key, it is possible to effect channel selections. For example, if a program depicted on the display 14 of the remote control unit 10 is highlighted, one need only depress the EZ NAV key 20 to select that channel for viewing on an associated television set (not shown) (11:5-11). However, the Darbee et al. reference does not specifically disclose a digital broadcast receiving set-top box transmitting electronic program guide data in a received digital broadcast data. However, this is not considered a patentable distinction. The examiner gives Official Notice that it is notoriously well known in the art of video distribution to transmit electronic program guide data in a digital broadcast and recover the electronic program guide information in a set-top box. Digital broadcast data is an established protocol that

accordingly allows the transmission of electronic program guide information with video data.

The examiner submits, therefore, that it would have been clearly obvious to one of ordinary skill in the art at the time the invention was made to modify the Darbee et al. reference set-top box to receive digital broadcast data as it would provide the electronic program guide data to said set-top box.

As to claim 3, wherein said digital broadcast receiver periodically transmits EPG data. The Darbee et al. reference discloses that it may be desirable to transmit blocks of program guide data to the remote control unit over additional intervals or, possibly, at random times (9:14-16), which satisfies the claimed periodic transmission of EPG data.

As to claim 4, wherein said program display and selecting apparatus comprises an operation means for operating said digital broadcast receiver. The Darbee et al. reference discloses a program executed by the microprocessor enables the remote control unit to perform conventional operations including, for example, ON, OFF, Volume up or Down and Channel Up or Down functions (7:43-49), which satisfies the claimed operation means for operating said digital broadcast receiver. Note, it is understood that the remote control disclosed in the Darbee et al. reference has a communication link to the set-top box (8:50-52) and thus remote control commands are directed toward the operation of said set-top box.

As to claim 5, wherein said program display and selecting apparatus comprises a transmitting means for transmitting operation information inputted into said operation means to said digital broadcast receiver; and said digital receiver comprises a receiving means for receiving the operational information transmitted from said program display and selecting apparatus. The Darbee et al. reference discloses a communication link between a remote control

Art Unit: 2614

unit and an associated set-top box (8:50-52). The Darbee et al. reference also discloses a remote control unit including IR transmitting and receiving circuits (7:10). The Darbee et al. reference does not specifically disclose a receiver comprising a receiving means for receiving the operation information transmitted from said program display and selecting apparatus but it is nonetheless inherent in the device for the purpose of establish a communication link between a remote control and set-top box.

As to claim 7, wherein said operation means selects a program to be monitored. The Darbee et al. reference discloses that if a program depicted on the display 14 of the remote control unit 10 is highlighted, one need only depress the EZ NAV key 20 to select that channel for viewing on an associated television set (11:8-11, also see Figure 1 and 8), which satisfies the claimed operation means selects a program to be monitored.

As to claim 8, a digital broadcast receiver comprising a transmitting means for transmitting EPG data contained in a received digital broadcast data; a receiving means for receiving EPG data transmitted from the digital broadcast receiver; and selecting apparatus comprising a receiving means for receiving EPG data transmitted from the digital broadcast receiver, comprising a display means for concurrently displaying said received EPG data. The Darbee et al. reference discloses a remote control unit with an IR or RF communication link to an associated set-top box (8:48-52) where the remote control unit includes an IR or RF transmitting and receiving circuits (7:10,18-21). The Darbee et al. reference also discloses that a program guide and advertising data signal may be combined with television channel signals on a coaxial cable to form a composite signal where the composite signal may be broadcast by a content provider, such as a cable company or satellite network, and delivered to a set-top box

Art Unit: 2614

(8:58-66). The Darbee et al. reference also discloses that the program guide is operated on a small 5-line by 20-character LCD screen or display that is provided on the remote control unit, which satisfies the claimed EPG data displaying means. The Darbee et al. reference also discloses in one particularly innovative aspect, the present invention is directed to a remote control unit having a graphic display for depicting program scheduling and/or advertising information without causing an interruption in content that is being depicted on an associated television monitor (2:45-50). The Darbee et al. reference also discloses it will also be appreciated that, by depressing the EZ NAV key, it is possible to effect channel selections. For example, if a program depicted on the display 14 of the remote control unit 10 is highlighted, one need only depress the EZ NAV key 20 to select that channel for viewing on an associated television set (not shown) (11:5-11). However, the Darbee et al. reference does not specifically disclose a digital broadcast receiving set-top box transmitting electronic program guide data in a received digital broadcast data. However, this is not considered a patentable distinction. The examiner gives Official Notice that it is notoriously well known in the art of video distribution to transmit electronic program guide data in a digital broadcast and recover the electronic program guide information in a set-top box. Digital broadcast data is an established protocol that accordingly allows the transmission of electronic program guide information with video data. The examiner submits, therefore, that it would have been clearly obvious to one of ordinary skill in the art at the time the invention was made to modify the Darbee et al. reference set-top box to receive digital broadcast data as it would provide the electronic program guide data to said set-top box.

As to claim 9, wherein said EPG data is transmitted periodically. The Darbee et al. reference discloses that it may be desirable to transmit blocks of program guide data to the remote control unit over additional intervals or, possibly, at random times (9:14-16), which satisfies the claimed periodic transmission of EPG data.

As to claim 12, an operation means for operating said digital broadcast receiver. The Darbee et al. reference discloses a program executed by the microprocessor enables the remote control unit to perform conventional operations including, for example, ON, OFF, Volume up or Down and Channel Up or Down functions (7:43-49), which satisfies the claimed operation means for operating said digital broadcast receiver. Note, it is understood that the remote control disclosed in the Darbee et al. reference has a communication link to the set-top box (8:50-52) and thus remote control commands are directed toward the operation of said set-top box.

3. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Darbee et al. (US 6,130,726) in further view of Huang et al. (US 6,437,836). The Darbee et al. reference discloses all the limitations of claim 4. However the Darbee et al. reference does not disclose wherein said operation means comprises a touch panel. The Huang et al. reference discloses operation means comprises a touch panel where an electronic program guide is seamlessly integrated with the remote: clicking on a program will allow one to immediately change to that program (Huang et al. 5:26-28, also see Figure 1A). Therefore, it would have been clearly obvious to one of ordinary skill in the art at the time the invention to modify the Darbee et al. remote control with the Huang et al. remote control system to provide specialized functionality and features by dynamically constructing the user's remote control buttons on a graphical touch screen (Huang et al. 4:23-27).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

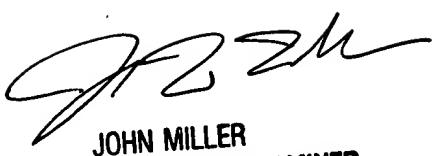
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Johnny Ma whose telephone number is (703) 305-8099. The examiner can normally be reached on 8:00 am - 6:00 pm (First Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (703) 305-4795. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-5399 for regular communications and (703) 308-5399 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

jm
April 4, 2003



JOHN MILLER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600